

REMARKS

Originally filed claims 1 – 17 are presented for reconsideration and further examination in view of the foregoing amendments and following remarks.

In the outstanding Office Action, the Examiner objected to the drawings as containing a mislabeled reference character; objected to the specification due to informalities; rejected claims 1 - 9 and 11 – 17 under 35 U.S.C. §102(b) as being anticipated U.S. patent No. 5,614,993 to Smith et al. (hereinafter referred to as “the Smith et al. ‘993 patent”); and claim 10 was rejected under 35 U.S.C. §103(a) as being unpatentable over the Smith et al. ‘993 patent.

By this Response and Amendment:

independent claim 1 has been amended to recite a “complete set of predetermined conditions” and independent claim 9 has been amended to recite storage as a package of the predetermined conditions that were displayed and, as amended, the rejections thereto and the rejections to the claims dependent thereon under 35 U.S.C. §102(b) are traversed; and

the rejection to claim 10 under 35 U.S.C. §103(a) is traversed.

It is respectfully submitted that the above amendments and corrections do not introduce any new matter to this application within the meaning of 35 U.S.C. §132, or any narrowing of any element of the claims. Support for the amendments to the independent claims can be found on page 3, lines 13 – 24 of the original application.

Objections to the Drawings

The Examiner objected to the drawings because the reference character for the part, “Dd” is mislabeled.

Response

Applicant notes with appreciation the Examiner's suggestions for correction. Attached to this response and amendment are corrected drawings that incorporate the Examiner's suggestions. In particular, in Fig. 4, reference number "10c" depicting text "Dd" was changed to --10d--.

Additionally, a substitute sheet of the drawings of Figs. 7A-7C is herewith submitted to correct the textual identification associated with the arrow between Fig. 7A and Fig. 7B. As originally submitted the arrow between Figs. 7A and 7B was mislabeled as "Press Setup Recognition Key 58". The herewith submitted replacement sheet corrects the label associated with the arrow so as to indicate that the transition from Fig. 7A to 7B is caused when the operator presses the --Setup Confirmation Key 58--. Support for the correction is found on page 14, lines 4-7 of the originally filed specification.

Accordingly, Applicant respectfully requests the Examiner to reconsider and withdraw the outstanding objection.

Objections to the Specification

The Examiner objected to the specification due to grammatical errors.

Response

Applicant notes with the appreciation the Examiner's suggestions for correction. By this Response and Amendment, the specification has been amended to incorporate the Examiner's suggestions.

Accordingly, Applicant respectfully requests the Examiner to reconsider and withdraw the outstanding objection.

Rejections under 35 U.S.C. 102(b)

The Examiner rejected claims 1 – 9 and 11– 17 under 35 U.S.C. §102(b) as being anticipated by the Smith et al. '993 patent.

Response

Independent claims 1 and 9 have been amended to obviate the Examiner's rejections under 35 U.S.C. 102(b). As amended, the rejections are traversed. In particular, Applicant amended claim 1 to recite that a "complete set of predetermined conditions" is stored and amended claim 9 to recite that the setup screen allows all items of the predetermined set-up conditions to be displayed as a package and that the set up conditions "that were displayed in the package" are stored.

Applicant respectfully submits that the cited Smith et al. '993 patent does not show all of the limitations of the independent claims as amended. For a reference to anticipate an invention, all of the elements of that invention must be present in the reference. The test for anticipation under section 102 is whether each and every element as set forth in the claims is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. V. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must also be arranged as required by the claim. *In re Bond*, 15 USPQ2d 1566 (Fed. Cir. 1990).

The present invention is directed toward an image forming apparatus in which a set of printing conditions can be input into the apparatus. The set of printing conditions is made up of individual instructions such as an instruction as to the scale of the image, the color of the image, the number of images to be produced, etc. This set of printing conditions is saved (stored) in the apparatus's memory as a unique package. As such, other printing conditions directed toward an

unrelated image can be entered and likewise saved in the apparatus's memory as a separate and distinct package. After this separate and distinct package of print conditions has been used and images formed therefrom, a user is able to recall the original package of print conditions, if necessary, and produce additional images based on the original set of print conditions.

Contrastingly, the Smith et al. '993 patent shows a system for producing a print job wherein instructions are input into the system and maintained throughout programming for a print job. Smith et al. refer to the set of instructions as summary information. *See the Smith et al. '993 patent* col. 2, lines 24 – 30. This summary information can be reviewed as the job is programmed. *Id.* at lines 30 – 32. The Smith et al. '993 patent discloses a memory; however, the memory disclosed in the Smith et al. '993 patent is used to store signal sets; there is no mention of the memory being used to store a package of set-up conditions for a print job such that the particular stored print job can be recalled and reused. This feature is missing from the Smith et al. '993 patent disclosure. Thus, the Smith et al. '993 patent cannot anticipate the present invention.

The Office Action additionally asserts that the summary screen, such as shown in Fig. 7 of the Smith et al. '993 patent, corresponds to the setup confirmation screen shown in Fig. 5 of the present application. Applicant respectfully disagrees. The summary screen of Smith et al. does not include a memory registration button such as memory registration button 11 shown in Figs. 9A-9C of the present application. Applicant submits that the Smith et al. reference neither discloses nor suggests that the setup confirmation screen is shifted to the memory registration screen by using the memory registration button provided within the setup confirmation screen, and as claimed in independent claim 1 and its associated dependent claims 5-6; and independent claim 9 and its associated dependent claims 14-15. Although Fig. 25 of Smith et al. shows a store/retrieve memory screen having a touch screen area labeled as "SAVE", Applicant submits that the Smith et al.

store/retrieve memory screen is related to and subordinate to job table key region 121 that are only formed with the buttons numbered as “1 to 60” and labeled with “Previous Job”, and that touch region 122 is only for storing the various operating feature selections into the hard memory portion of the logic unit L. Applicant further submits that even if referring to such a store/retrieve memory screen, Smith et al. neither discloses nor suggests that the setup confirmation screen is shifted to the memory registration screen by using the memory registration button provided within the setup confirmation screen. Applicant therefore submits that even if the Smith et al reference is referred to, this reference neither anticipates nor renders obvious the presently claimed features.

As such, Applicant asserts that the present invention is patentable over the cited Smith et al. ‘993 patent in view of the amendments to independent claims 1 and 9 as the Smith et al. ‘993 patent does not contain all of the limitations thereof. Claims 2 – 8 and 11 – 17 either directly or indirectly depend from claims 1 and 9 respectively; therefore, these claims are amended in view of their dependency and are likewise patentable over the Smith et al. ‘993 patent for at least the same reasons as the independent claims.

Accordingly, reconsideration and withdrawal of the rejections is respectfully requested.

Rejections under 35 U.S.C. §103(a)

The Examiner rejected claim 10 under 35 U.S.C. §103(a) as being unpatentable over the Smith et al. ‘993 patent.

Response

Applicant incorporates herein by reference the arguments presented above in response to the rejection of claim 9 under 35 U.S.C. §102(b). Since claim 9 as amended is now patentable over the Smith et al. ‘993 patent, claim 10, dependent therefrom, is likewise patentable thereover because all

of the elements of claim 10 are not taught or suggested by the Smith et al. '993 reference.

Accordingly, reconsideration and withdrawal of the rejection is respectfully requested.


CONCLUSION

In light of the foregoing, Applicant submits that the application is now in condition for allowance. If the Examiner believes the application is not in condition for allowance, Applicant respectfully requests that the Examiner contact the undersigned attorney if it is believed that such contact will expedite the prosecution of the application.

Respectfully submitted,
NATH & ASSOCIATES PLLC

Date: February 10, 2004
NATH & ASSOCIATES PLLC
1030 Fifteenth Street, N.W.
Sixth Floor
Washington, DC 20005
(202) 775-8383

By:



Gary M. Nath
Registration No. 26,965
Marvin C. Berkowitz
Registration No. 47,421
Derek Richmond
Registration No. 45,771